

United States Patent and Trademark Office

UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450 www.uspto.gov

APPLICATION NO). F	ILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO
09/902,555	0/902,555 07/10/2001		Pierre Hirsbrunner	81358-200	7190
28765	7590	02/25/2004		EXAM	INER
	N & STRA		•	KOSLOW, CAROL M	
PATENT DEPARTMENT 1400 L STREET, N.W. WASHINGTON, DC 20005-3502				ART UNIT	PAPER NUMBER
				1755	

DATE MAILED: 02/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

	,	/				
	Application No.	Applicant(s)				
	09/902,555	HIRSBRUNNER ET AL.				
Office Action Summary	Examiner	Art Unit				
	C. Melissa Koslow	1755				
The MAILING DATE of this communication app Period for Reply	ears on the cover sheet w	th the correspondence address				
A SHORTENED STATUTORY PERIOD FOR REPLY THE MAILING DATE OF THIS COMMUNICATION. - Extensions of time may be available under the provisions of 37 CFR 1.1: after SIX (6) MONTHS from the mailing date of this communication. - If the period for reply specified above is less than thirty (30) days, a reply - If NO period for reply is specified above, the maximum statutory period v - Failure to reply within the set or extended period for reply will, by statute Any reply received by the Office later than three months after the mailing earned patent term adjustment. See 37 CFR 1.704(b).	36(a). In no event, however, may a r within the statutory minimum of thin will apply and will expire SIX (6) MON cause the application to become AE	eply be timely filed y (30) days will be considered timely. THS from the mailing date of this communication. ANDONED (35 U.S.C. § 133).				
Status						
1) Responsive to communication(s) filed on 01 D	<u>ecember 2003</u> .					
2a) This action is FINAL . 2b) ☑ This	·					
	nce this application is in condition for allowance except for formal matters, prosecution as to the merits is used in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11, 453 O.G. 213.					
Disposition of Claims						
4) ⊠ Claim(s) <u>1-6 and 17-30</u> is/are pending in the all 4a) Of the above claim(s) is/are withdraw 5) ⊠ Claim(s) <u>20-26</u> is/are allowed. 6) ⊠ Claim(s) <u>1-5,18,19 and 27-30</u> is/are rejected. 7) ⊠ Claim(s) <u>6 and 17</u> is/are objected to. 8) □ Claim(s) are subject to restriction and/o	wn from consideration.					
Application Papers						
9) The specification is objected to by the Examine 10) The drawing(s) filed on is/are: a) accomplicated any not request that any objection to the Replacement drawing sheet(s) including the correct 11) The oath or declaration is objected to by the Example 11.	epted or b) objected to drawing(s) be held in abeyar ion is required if the drawing	ce. See 37 CFR 1.85(a). (s) is objected to. See 37 CFR 1.121(d).				
Priority under 35 U.S.C. § 119						
12) △ Acknowledgment is made of a claim for foreign a) △ All b) △ Some * c) △ None of: 1. △ Certified copies of the priority document 2. △ Certified copies of the priority document 3. △ Copies of the certified copies of the priority application from the International Bureau * See the attached detailed Office action for a list	s have been received. s have been received in A rity documents have been u (PCT Rule 17.2(a)).	pplication No received in this National Stage				
Attachment(s)						
1) Notice of References Cited (PTO-892) 2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date	Paper No(s	summary (PTO-413) s)/Mail Date nformal Patent Application (PTO-152) 				

Art Unit: 1755

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1 December 2003 has been entered.

The indicated allowability of claims 27-30 is withdrawn due to applicants' amendments to the claims and upon further consideration of applicants' arguments.

Claims 19 and 27 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

There is no teaching or suggestion in the specification or in the art that agricultural soil comprises gravel, tree bark, sawdust or other solid porous materials. Applicants need to show these compounds are conventional part of agricultural soils.

Claims 19 and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

These claims are indefinite since the "other solid porous materials" present in agricultural soil is not defined in the specification or in the art. Thus one of ordinary skill in the art cannot determine what materials applicants intend to encompass by this phrase.

Art Unit: 1755

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-5, 18, 19 and 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown.

This reference teaches a substrate treating solution for imparting hydrophobicity to the substrate consisting of an aqueous solution of an alkali metal silicate and an alkali metal alkyl siliconate. Run numbers 7-9 teach aqueous compositions containing 1.25 wt% sodium silicate and 0.25 wt% sodium methyl siliconate; 2.5 wt% sodium silicate and 0.5 wt% sodium methyl siliconate and 5 wt% sodium silicate and 1 wt% sodium methyl siliconate. The composition falls within the claimed range. Column 5, lines 40-55 teach the composition contains 0.1-10 wt% siliconate and 0.1-30 wt% silicate. These amounts overlap the claimed ranges. Product claims with numerical ranges which overlap prior art ranges were held to have been obvious under 35 USC 103. In re Wertheim 191 USPQ 90 (CCPA 1976); In re Malagari 182 USPQ 549 (CCPA 1974); In re Fields 134 USPQ 242 (CCPA 1962); In re Nehrenberg 126 USPQ 383 (CCPA 1960). Since the weight percentages overlap, one of ordinary skill in the art would be expect the molar ratios to also overlap, absent any showing to the contrary. The reference suggests the claimed composition. Since the claimed and taught composition overlap, one of ordinary skill in the art would expect the taught composition to have the claimed property of claims 1, 19 and 28 in the overlapping range and to have a composition that overlaps that of claim 18.

In response to applicant's arguments, the recitation "agricultural soil treating agent" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or

Art Unit: 1755

the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Applicants argue the claimed composition is used for treating soil to retain water to assist in crop growth. While the specification teaches the composition can have this use, it is also teaches the composition is used to render substrates, such as masonry, hydrophobic. There does not appear to be any compositional difference between the claimed agricultural soil treating agent and the composition when it is used to render substrates, such as masonry, hydrophobic. The rejection is maintained.

Claims 1-4, 18, 19 and 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weber et al.

This reference teaches a soil treating agent for imparting hydrophobicity to the substrate consisting of an aqueous solution of an alkali metal silicate and an alkali metal alkyl siliconate. Column 2, lines 31-32 that alkali metal silicate and alkali metal siliconate can be used in any weight ratio, which means that any molar ratio can be used. These amounts overlap the claimed ranges. Product claims with numerical ranges which overlap prior art ranges were held to have been obvious under 35 USC 103. *In re Wertheim* 191 USPQ 90 (CCPA 1976); *In re Malagari* 182 USPQ 549 (CCPA 1974); *In re Fields* 134 USPQ 242 (CCPA 1962); *In re Nehrenberg* 126 USPQ 383 (CCPA 1960). The alkali metal silicate is preferably sodium or potassium orthosilicate and the alkali metal siliconate is preferably sodium or potassium methyl siliconate. The reference suggests the claimed composition. Since the claimed and taught composition overlap, one of ordinary skill in the art would expect the taught composition to have the claimed

Art Unit: 1755

property of claims 1, 19 and 28 in the overlapping range and to have a composition that overlaps that of claim 18.

Claims 20-26 are allowable over the cited art of record.

Claims 6 and 17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

These claims are allowable for the reasons given in the previous office actions.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melissa Koslow whose telephone number is (571) 272-1371. The examiner can normally be reached on Monday-Friday from 8:00 AM to 3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell, can be reached at (571) 272-1362.

The fax number for all official communications is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

cmk February 19, 2004 C. Melissa Koslow Primary Examiner Tech. Center 1700